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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,329	03/14/2001	Alan Taylor	55,085-CIP (18102)	3854

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EXAMINER
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ASHBURN, STEVEN L

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 09/08/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/808,329

Applicant(s)

TAYLOR ET AL.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 14-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 14-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 13 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***DETAILED ACTION***

***Drawings***

The drawings were received on June 13, 03. These drawings are acceptable.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 41 is indefinite because it is dependant upon itself. For the purposes of examination, the examiner assume claim 41 depends upon claim 34.

***Claim Rejections - 35 USC § 102***

**Claim 26-32 is rejected under 35 U.S.C. 102(b) as being anticipated by Quinlan, U.S. Patent 5,671,921 (Sep. 30, 1997).**

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

**Claim 45 is rejected under 35 U.S.C. 102(b) as being anticipated by Roberts, U.S. Patent 5,772,510 (Jun 30, 1998).**

As listed below, *Roberts* teaches all the features of the claim:

- a. Receiving instructions for using the game ticket in conjunction with any one of a plurality of lottery-type drawing events wherein the instructions are on the reverse side of the ticket. *See fig. 2A-2C*. In particular, figures 2A-2C illustrate a lottery ticket with the preprinted message “See Ticket Reverse for Complete Five Play Lotto Information”. Hence the reference suggests the claimed feature of disposing on the reverse side of a ticket instructions for using the lottery ticket. The examiner notes that the language “plurality of lottery-type drawing events” does not require events of different types; instead the language only requires there be more than one event similar to a lottery.
- b. Providing a name of a lottery-type event on the game ticket. *See fig. 8B*.
- c. Providing a day of the week and time during which the lottery-type drawing takes place. *See id.*
- d. Providing an indicia of ownership and of intellectual property rights of an owner or sponsor of the game. *See id.*
- e. Indicating the playing life of the lottery ticket. *See id.* More specifically, the ticket’s life lasts until the 7:30 PM drawing indicated on the ticket’s face.
- f. Providing means for authenticating the ticket. *See id.* More specifically, the ticket includes a bar code and serial number for authentication purposes. *See col. 4:7-21*.

Consequently, the claim is unpatentable as being anticipated by *Roberts*.

### ***Claim Rejections - 35 USC § 103***

**Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Quinlan, U.S. Patent 5,671,921 (Sep. 30, 1997) in view of Roberts, U.S. Patent 5,772,510 (Jun 30, 1998).**

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*will* As listed below, *Quinlan* teaches ~~all~~ <sup>following</sup> the features of the claim:

- a. Substrate having an obverse and reverse side. *See fig. 1-5; col. 3:52-4:46.*
- b. Plurality of playing pieces which are disposed on the obverse side of the lottery ticket in at least one array comprising a plurality of panels, each of the panes comprising a number of playing game pieces. *See id.*
- c. Removable material having a surface that is disposed over, so as to conceal the plurality of playing game pieces wherein a plurality of unique indicia is deposited on the surface of the removable material so that each of the plurality of unique indicia corresponds to only one of the plurality of panels. *See id.*

However *Quinlan* lacks (i) instructions for using the lottery ticket in conjunction in any one of a plurality of lottery-type drawing events where instructions are disposed on the reverses side of the ticket; and (ii) a playing life of the lottery ticket. Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan.

*Roberts* discloses a system for providing lottery tickets allowing players to purchase a ticket for play at a later time for participation in a plurality of drawing events. *See fig. 1.* In particular regards to the claims, figure 2A illustrates a lottery ticket with the preprinted message "See Ticket Reverse for Complete Five Play Lotto Information". Hence the reference suggests the claimed feature of disposing on the reverse side of a ticket instructions for using the lottery ticket in conjunction in any one of a plurality of lottery-type drawing events. Additionally, figure 2A illustrates that the ticket is used in a drawing at a 7:00 PM drawing. Hence, it suggests the claimed feature of providing a playing life of the lottery ticket.

In view of *Roberts*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Quinlan* to add the features of instructions for using the lottery ticket in conjunction in any one of a plurality of lottery-type drawing events where instructions are disposed on the reverses side of the ticket; and a playing life of the lottery ticket. As suggested in *Roberts* the modification

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enhances a game ticket by informing them of the lottery rules and by allowing players to purchase a ticket for play at a later time and thereby increase revenues by allowing a greater number of players to participate by purchasing tickets at their convenience. *See fig. 2A; col. 2:1-8, 2:33—39.*

**Claims 14-24, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quinlan in view of Kamille, U.S Patent 5,855,514 (Jan 5, 1999).**

In regards to independent claim 14: *Quinlan* teaches all the features of the claims except said the combination of playing panels comprising some but not all of the plurality of panels. Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan.

*Kamille* teaches that is was known the art to have players pick some but not all selections from a set of selections to control the odds of picking a winning selection and thereby controlling the game's expected payout. *See col. 1:56-2:3.* For example, in the case of a lottery ticket, picking three or four selections from a set of five possible selections. Notably, having players pick selections increases the player's excitement by relating the game result to the player's choice.

Consequently, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Quinlan*, wherein a player reveals a set of game panel, to add the feature of revealing some but not all of the plurality of panels to control the game's expected payout and increase players' excitement.

Claim 15-17: *Quinlan* discloses games which three or five panels are revealed. *Quinlan* further suggests that the game may be varied to various configurations, graphics and symbols. Hence: *Quinlan* additionally suggests the number of playing game pieces in each of the plurality of panels three or four. *See fig. 3-5; col. 4:12-21.*

Claim 18: *Quinlan* teaches having at least three of the plurality of panels being consecutive. *See fig. 1-5.*

Claim 19: *Quinlan* teaches a plurality of playing game pieces are revealed by removing a removable material that is disposed over, so as to conceal, the plurality of playing game pieces. *See fig. 1-5.*

Claims 20: *Kamille* teaches designating a unique sub-population of playing game pieces selected from a total population of playing game pieces so that each unique sub-population of playing game pieces is disposed as the playing game pieces in only of the plurality of panels; authenticating the validity of the lottery ticket and awarding a prize for each winning game ticket. *See fig. 4a; col. 11:65-16:5.*

Claims 21 and 23: *Kamille* teaches having the number of winning game pieces selected being equal to the number of game pieces revealed. *See fig. 16-19.*

Claim 22: *Kamille* teaches having some but not all of the plurality of winning game pieces being selected from each of the unique sub-populations of playing game pieces designated for each of the plurality of panels selected. *See fig. 4(a)(b), 7(b); 7:17-9:46.*

Claim 24: *Kamille* teaches having a ticket be a winning lottery ticket if a combination of winning game pieces matches a combination of revealed playing game pieces in the playing panel so that at least three of the revealed playing game pieces adjoin horizontally. *See fig. 1-5.*

Claim 33: This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

**Claims 34-40 and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Quinlan* in view of *Goodson* et al., U.S. Patent 5,927,716 (Jul. 27, 1999).**

In regards to independent claims 34 and 49: *Quinlan* teaches all the features of the claims except receiving a drawing event designation that designates the panels to be used in the game. Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan in view of *Goodson*.

*Roberts* discloses an analogous lottery system in which a player receives a designation of which panels are to be used in the game. *See col. 2:43-49; 4:61-5:21*. As a result, the lottery system prevents the re-use and stockpiling of lottery tickets. *See col. 1:9-14*.

In view of *Goodson*, it would have been obvious to an artisan at the time of the invention to modify the lottery system disclosed by *Quinlan*, wherein players uncover panels in game, to add the feature of receiving a drawing event designation that designates the panels to be used in the game. As suggested by *Roberts*, the modification would enhance the lottery system by preventing the re-use and stockpiling of lottery tickets. *See col. 1:9-14*

In regards to claim 35: *Quinlan* additionally teaches a plurality of playing game pieces comprising a series of integers. *See fig. 5; col. 4:12-21*.

In regards to claims 36-38, 42 and 43: *Quinlan* additionally teaches the number of playing game pieces in each of the plurality of panels three or four. *See fig. 3-5; col. 4:12-21*.



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In regards to claim 39: *Goodson* additionally teaches revealing all of the game pieces disposed under a combination of playing panels wherein the combination of panels includes some but not all of the panels and the combination of panels is unique to each drawing of a plurality of lottery-type events. *See col. 2:43-49; 4:61-5:21.*

In regards to claim 40: *Quinlan* additionally suggests revealing three panels. *See id.*

In regards to claim 41: *Quinlan* teaches having at least three of the plurality of panels being consecutive. *See fig. 1-5.*

In regards to claim 44: The combination of *Quinlan* and *Goodson* describe every feature of the claim except a free space. Regardless, this feature would have been obvious to an artisan at the time of the invention. It is notoriously well known in the art of gaming to include outcomes, such as free spaces, wild cards or jokers, that can be combined with any other game indicia to complete a predetermined winning combination with fewer winning outcomes. For example, a slot machine outcome of “7-7-Wild” would payout an award for the equivalent outcome a predetermined winning combination of “7-7-7”. In further example, a poker outcome of “Ace-Ace-Wild-Ten-Two” would payout for a predetermined winning combination “three of a kind”. Likewise, in a bingo game, a free space may be combined with other random outcomes to complete a predetermined winning combination. As a result, free spaces, wild cards or jokers enhance a game’s excitement by giving player’s a greater chance of completing winning combinations. Consequently, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Quinlan*, wherein players are paid awards for outcomes comprised of predetermined winning combinations, to add the feature of one of the plurality of game pieces comprising

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a free space to enhance a game's excitement by giving player's a greater chance of completing winning combinations.

In regards to claim 47: *Quinlan* additionally teaches selecting a plurality of winning game pieces. *See fig. 1, 5; col. 4:5-21.*

In regards to claim 48: *Quinlan* additionally teaches awarding a prize based on the number of winning lines on the game ticket. *See fig. 2-5.*

**Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Roberts* in view of *Fulfs et al.*, U.S. Patent 5,788,237 (Aug. 4, 1998).**

*Roberts* additionally teaches means for authenticating a ticket including a a machine-readable bar code and a batch control number. *See fig. 2B(20a,20b).* Thus, the combination of *Roberts* teaches all the features of the claim except a concealed validation symbol that is disposed on the lottery ticket wherein each of the plurality of panels is associated with a unique verification symbol that is revealed along with the playing game pieces. Regardless of the deficiency, this features were known in the art at the time of the invention and would have been obvious to an artisan in view of *Fulfs*.

*Fulfs* discloses an analogous lottery ticket wherein panels are opened by a player to reveal a plurality of playing game pieces. *See fig. 1-4.* In particular, some panels are associated with a unique verification symbol that is revealed along with the playing game pieces to increase the security of the

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system by providing an additional means of verification for winners of large instant win awards. *See fig. 4; col. 4:545:10.*

In view of *Fults*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the lottery ticket described *Roberts* to add the feature of a concealed validation symbol that is disposed on the lottery ticket wherein each of the plurality of panels is associated with a unique verification symbol that is revealed along with the playing game pieces increase the security of the system by providing an additional means of verification.

**Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Quinlan* in view of *Kamile*, as applied to claim 14 above, in further view of Scrymgeour et al., U.S. Patent 6,347,794 B2 (Feb 19, 2002).**

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

#### ***Response to Arguments***

In response to the applicant's request, the examiner acknowledges applicant's claim of priority to copending application 09/794,266 filed February 27, 2001.

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Applicant's arguments with respect to claims 1 have been considered but are moot in view of the new ground(s) of rejection necessitated by the applicant's amendment.

In regards to claims 26-27, 28 and 31: The applicant argues that the claims distinguish from *Quinlan* because the reference does not teach a random selection device as required by claim 26. More specifically, the applicant asserts that *Quinlan's* seal card is not a selection device because no winning game piece is selected. The examiner respectfully disagrees. The seal card illustrated in figure 1 contains a random outcome that selects a game piece which wins the opportunity to participate in a bonus round.

Consequently, the rejection is maintained. *Claim language fails to preclude Quinlan's game.* *met*

In regards to claims 14-18 and 20-24: The applicant argues that *Quinlan* does not disclose random selection of winning game pieces after the game participant has the game ticket as required by independent claim 14. The examiner respectfully disagrees. First, it is noted that the features upon which applicant relies are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, the claim merely requires randomly selecting a plurality of winning game pieces. The claim does not require selection of game winning game pieces *after the game participant has a game ticket*. Second, *Quinlan* teaches the feature of randomly selecting a plurality of winning game pieces. More specifically, winning game pieces are randomly distributed to game tickets. The player selects the game pieces. Hence, the player's selection from the random distribution of winning game pieces constitutes a randomly selecting a plurality of winning game pieces. Notably, the claims do not require the random selection to be made external to the game ticket. Consequently, for the above reasons, the rejection is maintained.

In further regards to claim 14: The applicant asserts that modifying *Quinlan* such that all panels are opened would render the game inoperable. The examiner respectfully disagrees. The standard of patentability is what the prior art, taken as a whole, suggests to an artisan at the time of the invention. *In re Merck & Co., Inc.*, 800 F.2d 1091,1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The question is not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 1390, 174 USPQ 114, 116 (CCPA 1972). In this case, *Quinlan* discloses a pull-tab ticket game in which players remove panel wherein each panel includes an independent game outcome. *See col. 4:40-46*. *Kamille* teaches that it was known the art to have players pick some but not all selections from a set of selections to control the odds of picking a winning selection and thereby controlling the game's expected payout. *See col. 1:56-2:3*. For example, in the case of a lottery ticket, picking three or four selections from a set of five possible selections. Notably, having players pick selections increases the player's excitement by relating the game result to the player's choice. When the prior art is taken as a whole, it collectively suggests to an artisan a pull tab game in which some but not all of the plurality of panels are revealed to control the game's expected payout and increase players' excitement. Consequently, the rejection is maintained.

In regards to claim 25: The applicant argues that *Scrymgeour* does not teach the feature of a plurality of discrete gaming panel having a plurality of gaming pieces that are revealed so that the ticket can be used in more than one drawing event. The examiner respectfully disagrees. First, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The standard of patentability is what the prior art, taken as a whole, suggests to an artisan at the time of the invention. *In re Merck & Co., Inc.*, 800 F.2d 1091,1097, 231 USPQ 375, 379 (Fed. Cir.

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1986). The question is not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 1390, 174 USPQ 114, 116 (CCPA 1972). In this case, *Quinlan* discloses a pull-tab ticket game in which players remove panel wherein each panel includes an independent game outcome. *See col. 4:40-46*. *Kamille* teaches that it was known the art to have players pick some but not all selections from a set of selections to control the odds of picking a winning selection and thereby controlling the game's expected payout. *See col. 1:56-2:3*. *Scrymgeour* discloses an analogous lottery ticket having a plurality of discrete game panels having a plurality of playing game pieces that are revealed so that the lottery ticket can be used for more than one drawing event, which drawing events involve separate selection of winning game pieces and separate determination of whether the lottery ticket is a winning lottery ticket. *See fig. 6, 7*. When the prior art is taken as a whole by an artisan, it collectively suggests a lottery system having tickets allowing selection of one or more discrete panels where more than one of the plurality of playing game pieces are revealed so that the lottery ticket can be used for more than one drawing event, which drawing events involve separate selection of winning game pieces and separate determination of whether the lottery ticket is a winning lottery ticket to enhance the utility of the lottery ticket by offering more than one game on a single ticket and thereby make the ticket more attractive to players. Consequently, the rejection is maintained.

In further regards to claim 25, the examiner notes that the applicant's assertion that the prior art does not describe the feature of a drawing event. The examiner respectfully disagrees. The applicant's argument suggest that the drawing event must be made external to the ticket after the ticket is purchased. However, no such requirement is captured in the language of the claim.

### ***Conclusion***

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.

s.a.

A handwritten signature in black ink, appearing to read 'MS', with a long horizontal flourish extending to the right.

MARK SAGER  
PRIMARY EXAMINER